

Thus of the claims on appeal, claims 2, 3, 5, 6, 11/2 - 10, 12/11/2-10, 15/3,4,8,9; 16/11/2-10, 17, 18, 25, 26, 35/2,3,5,6,17,18,25,26; and 36/35/2,3,5,6,17,18,25,26 are also still pending and were found patentable over the prior art applied by the examiner and over the prior art applied by the Board. They should be listed as allowed, since they were not rejected by the examiner in the recent final Office action, which merely applied the Board's rejection.

Claims 4, 7-10, 13, 14, 19- 24 and 27-34 were withdrawn from consideration initially, but are still in the application. Paper No. 9 recognized that claim 1 is generic and indicated dependent claims would be allowed with allowance of a generic claim; e.g., that claims 7-10 should be allowable if claim 1 is allowed. Also see Paper No. 18. Presumably any of the claims withdrawn from consideration should be allowable if a parent claim is allowed. Thus, claim 7, dependent on allowed claim 5 should be allowed. Similarly, claim 10, dependent on claim 2; 13 dependent on 11; 14 dependent on 13; 19 dependent on 17; 32 dependent on 2; and 33 dependent on 32 should be allowed. In addition, based on the rationale of the claims allowed by the Board, applicant submits that claims 21-26, 29 and 31 should be allowed. This leaves only claims 20 and 27-30 withdrawn. And, upon allowance of claim 1, all of the claims withdrawn as to nonelected species should then be allowed. Thus all of the previously withdrawn claims should have been shown as pending and the appropriate ones as identified above should have been allowed along with the claims that were on appeal and not rejected.

An Office action acknowledging the above indicated condition of the claims would be appropriate.

Applicant traverses the rejection of claims 1, 11/1, 12/11/1, 15/1, 16/11/1,

35/1, and 36/35/1 under 35 USC 103. Applicant submitted reasons for the traversal and a Declaration of Mr. Hummel with his Amendment and Response After Decision of Board, filed December 22, 2000. The examiner has found the declaration and arguments insufficient to overcome the rejection. The examiner has concluded that even though the Vectran M is 10 - 12 times more expensive than polyester or nylon and has disadvantageous increased stiffness, does not preclude his determining without evidence that the substitution of it for polyester or nylon is obvious. With respect to the disadvantageous increased stiffness of Vectran M, he asserts there is nothing within the disclosure of Bettcher that would preclude the inclusion of a stiffer fiber as a wrapping. That is not the test for unobviousness. These conclusions are contrary to the evidence applicant has submitted. Even though Bettcher may not preclude use of Vectran M in place of polyester or nylon, that does not make the substitution obvious. Bettcher does not suggest such a substitution. No motivation for such a substitution has been proposed by the examiner, and none can be assumed in view of the evidence presented by applicant of the disadvantages and hence disincentive to the substitution, absent of a recognition in the prior art of the increased cut-resistance that would be provided by the substitution. Such motivation is required for obviousness.

The examiner's attention is called to In re Soni, 34 USPQ2d 1684 (Fed. Cir. 1984) cited on page 5 of applicant's Amendment After Final Rejection, filed January 18, 1996. That decision holds that evidence of an unexpected improved result should suffice to establish unexpected results in the absence of contrary evidence. No contrary evidence has been presented. See also, In re Piasecki, 745 F.2d 1468 (Fed. Cir. 1984) where the court held that rebuttal of a prima facie case of obviousness is merely a showing of facts supporting an opposite conclusion, and may relate to any of

the Graham factors, including so-called secondary factors. In addition to the most recent declaration filed December 22, 2000, the supplemental declarations of Hummel filed January 18 and August 22, 1996 and also the declaration filed April 19, 1995 set forth evidence of unexpected results. The declaration of December 22, 2000 presented after the Board's decision and new ground of rejection sets forth facts that specifically rebut the prima facie case of obviousness set forth in the final rejection.

In sum, it is submitted that the absence of contrary evidence and absence of motivation for the substitution proposed by the examiner requires withdrawal of the rejection and allowance of the claims. Applicant points out that this additional evidence set forth in the recent declaration of Mr. Hummel was not before the Board when it applied its rejection of the claims now rejected by the examiner, there was no indication the Board had considered the earlier declarations, and the allowance of the claims on the present record would not be contrary to the Board's previous decision.


This response was not filed earlier because the final Office action was the first action following the referral of the application to the examiner by the Board.

Applicant's attorney telephoned the examiner and left messages several times to discuss the failure to show the pending claims that were not rejected and to discuss the merits of the rejection, but the calls were not returned.

In view of the foregoing, reconsideration and withdrawal of the final rejection, and allowance of the pending claims in this application are respectfully requested.

Dated June 19, 2001

Respectfully submitted,

  
James G. Watterson  
Reg. No. 20,180